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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---|---|
| Proceeding | 91217448 |
| Party | Defendant<br>Ocean Queens International Inc. |
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| Submission | Motion to Dismiss - Rule 12(b) |
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| Date | 08/28/2014 |
| Attachments | Motion to Dismiss.pdf(544384 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. Ser. No. 86/127,104
Filed on November 22, 2013
For the Mark EL-WADY EL-GIDID CO.

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| El Wady El Gidid Co. | : | |
| Opposer, | : | Opposition No. 91/217,448 |
| v. | : | |
| Ocean Queens International Inc. | : | |
| Applicant. | : | |

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UNDER FEDERAL RULE 12(b)(6), AND IN THE ALTERNATIVE, MOTION FOR A MORE DEFINITE STATEMENT UNDER FEDERAL RULE 12(e)**

Ocean Queens International Inc. moves the Board to dismiss the Notice of Opposition (the "Notice") under Fed.R.Civ.P. 12(b)(6) on the grounds that the Notice fails to state a claim upon which relief can be granted.

I. **Motion to Dismiss for Failure to State a Claim under Fed.R.Civ.P. 12(b)(6)**

In an opposition proceeding, an opposer must allege facts in its pleadings that, if proven, would establish that the opposer is entitled to the relief sought, by properly pleading that the opposer possesses standing to challenge the applicant's right to registration, and that there is a valid ground why the applicant is not entitled to register its mark, Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 (TTAB 1985), See Young v.

AGB Corp., 47 USPQ 2d 1752 (CAFC 1998), See also Carano v. Vina Concha Y Toro S.A., 67 USPQ2d 1149 (TTAB 2003) (the Board held that because the notice of opposition solely made allegations regarding copyright infringement, such allegations were not sufficient to establish that opposer plead a valid ground for denying the registration sought under the Lanham Act, and accordingly, granted the applicant's motion to dismiss for failure to state a claim.)

In the Young case, the opposer filed a Notice of Opposition stating a variety of facts detailing the relationship between the opposer and the applicant, as well as a plain statement indicating that the opposer would be damaged if the opposed application were to register. Young at 1753. The CAFC held that a mere statement of economic damage is sufficient to establish damage, but that merely making a statement regarding damages was not sufficient to establish that the pleading contained the requisite statutory grounds for the opposition pursuant to 37 C.F.R. § 2.104(a), which states "The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and *state the grounds for opposition.* (emphasis added)" Accordingly, because the opposer's pleading in the Young case failed to meet this basic standard, the CAFC affirmed the Board's decision to grant the applicant's motion to dismiss.

In the current case, the Notice of Opposition does not contain separate paragraphs, but rather, a singular paragraph, which reads as follows:

"The trademark in question, El-Wady El-Gidid should not be allowed to be registered to Ocean Queens International Inc. The original trademark has been in use and registered for several decades, since 1989, in Egypt. The hookah charcoal produced by the Opposer has been imported into the US for several years, from at least 2004. The product has born the same name and symbol during that time period. This name and symbol have been synonymous with the opposer's brand

of Hookah Charcoal. To allow the applicant to register this trademark would be in force to cancel an existing common law trademark in use for over a decade."

Applicant submits that the present case is somewhat analogous to the Young case, in that while various facts were stated regarding the relationship between Opposer and Applicant and their respective marks, the failure to plead a statutory ground upon which Applicant's application for registration should be denied is a fatal flaw that should result in the granting of the present motion to dismiss. Nothing in the paragraph provided makes any reference whatsoever to a statutory ground upon which Applicant's EL-WADY EL-GIDID CO. mark should be refused. In addition, the paragraph comprising the Opposition Notice does not contain any specific reference to the mark in which Opposer has claimed an alleged earlier right. As a result, Opposer's pleadings do not establish appropriate standing to maintain the proceeding.

Therefore, Applicant submits that Opposer's pleadings are fatally defective in that they do not include grounds for the opposition, and further because they do not make any reference to the mark in which Opposer is allegedly claiming rights, do not establish the requisite standing necessary to proceed with the Opposition. Accordingly, Applicant moves that the Opposition, therefore, be dismissed for a Failure to State a Claim upon which Relief can be Granted.

## II. **Motion for a More Definite Statement under Fed.R.Civ. P. 12(e)**

In the alternative, Applicant moves for a more definite statement of Opposer's pleadings with regard to the marks it is pleading pursuant to Fed.R.Civ.P. 12(e) and TBMP § 505, which states that if "a pleading to which a responsive pleading must be made is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement" provided that the motion "point(s) out the defects complained of, specif(ies) the details which the movant desires to have pleaded, and indicate(s) that the movant is unable to frame a responsive pleading without the desired information."

Further to this point, the Trademark Trial and Appeal Board has previously held that it is appropriate to require an opposer to plead with greater specificity with regard to the allegations in a notice of opposition in order to allow an applicant to file an appropriately responsive pleading. CBS Inc. v. Mercandante, 23 USPQ2d 1784 (TTAB 1992). In CBS, Inc., the opposer asserted likelihood of confusion with regard to its "RESCUE 911" mark which was registered in connection with television shows, alleging that the pleaded mark was likely to be confused with the applicant's "911 Rescue Bars" mark, which was intended to be used in connection with candy bars. Id. at 1785. In CBS's pleadings, it was unclear whether the opposer was alleging confusion based on its use of the mark on the collateral merchandise used to promote its television show, or based on the use of the RESCUE 911 mark for the television show itself. Id. at 1787. The Board held that because of the lack of clarity in this particular pleading, the opposer was required to specify which goods/services it was alleging that the applicant's mark was likely to be confused with. Id. at 1788.

In the present case, in the event that the Board denies Opposer's Motion to Dismiss and determines that Opposer has sufficiently stated a claim basis upon which relief can be granted, Applicant submits that a more definite statement of the pleadings with respect to the following sentences must be clarified in order for Applicant to appropriately craft a responsive pleading to the allegations contained in the Notice of Opposition:

Original Language

1) **"The original trademark has been in use and registered for several decades, since 1989, in Egypt."**

This statement is indefinite because it does not specify what the "original trademark" is, nor does it reference a registration number. As a result of the fact that this statement does not make a reference to the mark in which Opposer is claiming rights, Applicant cannot properly

respond thereto, as Applicant could not possibly admit or deny this allegation if it does not know which mark is being referred to, and therefore requests that the Opposer be required to state what the "original trademark" is, as well as the registration number for the alleged "original trademark".

2) **"The product has born the same name and symbol during that time period. This name and symbol have been synonymous with the opposer's brand of Hookah Charcoal."**

This statement is indefinite because the Notice of Opposition does not state the "name" or "symbol" born [sic] on the product, nor does it state the "name" or "symbol" that have allegedly become synonymous with the "opposer's brand of Hookah Charcoal". As a result of the fact that the Notice of Opposition does not reference the "name" or "symbol" in which Opposer appears to be attempting to allege certain rights, it is not possible for Applicant to properly file a responsive pleading as without this knowledge, Applicant cannot properly admit, or deny this allegation, as it could not possibly know the accuracy of these assertions if the alleged "name" and symbol" are not listed, and therefore requests that Opposer be required to state the "name" and "symbol" in which it is apparently alleging rights.

As the above sentences included in Opposer's pleadings are so vague, in the event that the Board denies Applicant's Motion to Dismiss, Applicant respectfully requests that its motion for a More Definite Statement be granted, requiring the Opposer to clarify the listed sentences, which would permit Applicant to appropriately frame a responsive pleading thereto.

**Conclusion**

Applicant submits that because Opposer failed to demonstrate its standing to bring the opposition, in addition to failing to list grounds upon which Applicant's mark should be refused, that Opposer has failed to state a claim upon which relief can be granted, and that as a result, the instant Opposition should be denied. However, in the alternative, in the event that Applicant's

Motion to Dismiss is denied, Applicant requests that its Motion for a More Definite Statement regarding the clauses set out herein be granted, requiring Opposer to clarify the specific concerns set out herein.

Respectfully submitted,

Attorneys for Ocean Queens International Inc.

By: _____

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UNDER FEDERAL RULE 12(b)(6), AND IN THE ALTERNATIVE, MOTION FOR A MORE DEFINITE STATEMENT UNDER FEDERAL RULE 12(E) is being deposited with the United States Postal Service as first class mail, postage prepaid, to counsel for Opposer on this 28th day of August, 2014 as follows:

Marco M. Shawki, Esq.
26 Rice Run
East Brunswick, New Jersey 08816

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Keith A. Weltsch